REMARKS

I. Introduction

Claims 17-33 remain pending in the present application. Claims 26-30 and 32-33 have been withdrawn from consideration. Claims 17-25 and 31 under consideration have been rejected. Claim 31 has been amended. In view of the following remarks, it is respectfully submitted that all of the pending claims under consideration are allowable, and reconsideration of the present application is respectfully submitted.

II. Rejection of Claims 17-24 under 35 U.S.C. § 102(a)

Claims 17-24 have been rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent App. Pub. No. 2002/0049535 ("Rigo"). It is respectfully submitted that claims 17-24 are not anticipated by Rigo for at least the following reasons.

To anticipate a claim under § 102(a), a single prior art reference must identically disclose each and every claim element. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claims 17-19 recite, in relevant parts, "**subdividing the telematics service** into partial telematics functionalities that are critical with respect to time **and** partial telematics functionalities that are not critical with respect to time." Although the Examiner contends that Fig. 2 and paragraphs [0043] and [0047] of Rigo teach "**subdividing the telematics service** into partial telematics functionalities that are critical with respect to time,"

and that Figs. 1-3 of Rigo teach "**subdividing the telematics service** into . . . partial telematics functionalities that are not critical with respect to time," there is absolutely no suggestion in any part of Rigo regarding **any subdivision of the telematics service**, let alone any suggestion of subdivision of the telematics service into **two separate partial services based on whether the particular telematics functionalities are critical (or not critical) with respect to time**. To the extent the Examiner cites paragraphs [0043] and [0047] of Rigo teach "**subdividing the telematics service** into partial telematics functionalities that are critical with respect to time," Applicants note that paragraph [0043] merely discloses that the computer 42 of the **telematics unit 32 obtains some data** from the central station 22 via the Internet connection, and paragraph [0047] merely discloses "various input functionalities associate with the on-board automated telematics and multi-media unit 32," but there is no reasonable basis to conclude that paragraphs [0043] and [0047] have anything to do with "**subdividing the telematics service** into partial telematics functionalities that are **critical with respect to time**," particularly since paragraphs [0043] and [0047] do not suggest that **anything** is subdivided based on the **criticality with respect to time**. In addition, to the extent the Examiner contends that Figs. 1-3 of Rigo teach "**subdividing the telematics service** into . . . partial telematics functionalities **that are not critical with respect to time**" because Figs. 1-3 show "a plurality of service providers are wirelessly connected with the vehicle telematics unit 32," Applicants respectfully submit that this contention is completely illogical: whether "a plurality of service providers are wirelessly connected with the vehicle telematics unit 32" has absolutely no relevance to "**subdividing the telematics service** into . . . partial telematics functionalities **that are not critical with respect to time**," let alone provide any suggestion of such subdivision. To the extent the Examiner is somehow contending that Figs. 1-3 and paragraphs [0043] and [0047] of Rigo, as a whole, teach **subdividing the telematics service** into **two separate partial services** based on **whether the particular telematics functionalities are critical (or not critical) with respect to time**, there is simply no logical or factual basis for this conclusion. In summary, the Examiner's assertions regarding the teaching of Rigo with respect to the claimed "**subdividing the telematics service**" based on the **criticality with respect to time** are completely unsupported because Rigo simply does not teach or suggest that **anything** is subdivided based on the **criticality with respect to time**. For at least these reasons, claims 17-19, as well as dependent claims 20-24, are allowable over Rigo.

Independent of the above, independent claims 17 and 19 further recite "executing in the data terminal **the partial telematics functionalities that are critical with respect to time**." As mentioned above, there is no suggestion in Rigo (including Fig. 2 and paragraphs [0043] and [0047] cited by the Examiner) regarding any **division of the telematics service into two separate partial telematics functionalities**, let alone that **anything** (including the telematics service) is **subdivided based on the criticality with respect to time** and separately executed in the data terminal. For at least this reason, claims 17 and 19, as well as dependent claims 20-24, are allowable over Rigo.

Independent of the above, independent claims 17 and 18 further recite "executing in the server **the partial telematics functionalities that are not critical with respect to time**." As mentioned above, there is no suggestion in Rigo (including Figs. 1-3 cited by the Examiner) regarding any **division of the telematics service into two separate partial telematics functionalities**, let alone that **anything** (including the telematics service) is **subdivided based on the non-criticality with respect to time** and separately executed in the server. For at least this reason, claims 17 and 18, as well as dependent claims 20-24, are allowable over Rigo.

III. Rejection of Claim 31 under 35 U.S.C. § 102(a)

Claim 31 has been rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Publication No. 2002/0000044049 ("Saito"). It is respectfully submitted that claim 31 is not anticipated by Saito for at least the following reasons.

To anticipate a claim under § 102(a), a single prior art reference must identically disclose each and every claim element. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection,

the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 31 recites, in relevant parts, "activating a diagnosis mode in **a control unit located in the vehicle**; **transmitting diagnosis commands from the server to the control unit via the data terminal**; transmitting answers resulting from execution of the diagnosis commands from the **control unit** to the **server** via the **data terminal**." According to claim 31, the **diagnosis commands** are sent **from the server to the in-vehicle control unit**, and the **in-vehicle control unit transmits the answers resulting from execution of the diagnosis commands to the server**. However, nothing in Saito even remotely suggests that the **diagnosis commands** are sent **from the server to the in-vehicle control unit**; instead, Saito (e.g., paragraph [0009]) merely suggests sending diagnostic data from the vehicle to a remote server. Furthermore, the diagnostic data sent from the vehicle to the remote server are clearly not **answers** resulting from **execution of the diagnosis commands sent from the server**, and therefore Saito clearly does not suggest the claimed feature that the **in-vehicle control unit transmits the answers resulting from execution of the diagnosis commands to the server**. For at least this reason, claim 31 is allowable over Saito.

IV. Rejection of Claim 25 under 35 U.S.C. § 103(a)

Claim 25 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Rigo in view of U.S. Patent No. 6,647,323 ("Robinson"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed.

Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In addition, not only must the cited references teach or suggest each element of the claim, but the prior art must also suggest the desirability of combining the elements in the manner contemplated by the claim, and the mere fact that references can be combined or modified does not render the resultant combination obvious. M.P.E.P. § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)).

Claim 25 ultimately depends on claim 17. As discusses above, claim 17 is clearly not anticipated by Rigo. In addition, Robinson clearly does not remedy the deficiencies of Rigo as applied against parent claim 17. Accordingly, Applicants respectfully submit that dependent claim 25 is not rendered obvious by the combination of Rigo and Robinson, and withdrawal of the rejection is requested.

V. Conclusion

In view of all of the above, it is respectfully submitted that all of the presently pending claims 17-25 and 31 under consideration are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

(R. No. 36,197)

Dated: November 20, 2007

By: JONG LEE for Gerard Messina

Gerard A. Messina
(Reg. No. 35,952)
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646